

REMARKS**Summary of the Final Office Action**

Claims 9 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ijichi et al. (U.S. Patent No. 6,542,445) (hereinafter "Ijichi").

Claims 10-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ijichi.

Summary of the Response to the Office Action

Applicants propose to amend claims 9, 13, 14, 17, and 18 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 9-18 remain pending for consideration.

Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 9 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ijichi. Claims 10-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ijichi. Applicants propose to amend claims 9, 13, 14, 17 and 18 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

In the Final Office Action, the Examiner asserts that the logical positions of TRK1 – TRK5 have been changed from their positions within the TOC according to their new positions within the two play-lists as shown in Fig. 7 of Ijichi. Applicants respectfully submit that this assertion is technically inaccurate for at least the following reasons.

Applicants respectfully submit that the playlists described in Ijichi as PL1 and PL2, for example, are tables that are provided in order to indicate the order of reproduction of particular tracks included in the TOC. There is no disclosure in Ijichi of changing the logical position of a track from the TOC position to a playlist position. As a result of the playlists PL1 and PL2 of the Ijichi arrangement, any of the tracks of the TOC can simultaneously be registered in more than one playlist. For example, in Fig. 7 of Ijichi, TRK3 is registered in both playlists PL1 and PL2 simultaneously.

From the Examiner's assertions in the Final Office Action regarding the alleged updating of the TOE in Ijichi, it appears that the Examiner believes that Ijichi discloses that its playlist PL1 is changed to playlist PL2. However, Ijichi includes no teaching, or even a suggestion, that this is the case. Instead, PL1 and PL2 of Ijichi are two completely separate and independent playlists that exist simultaneously.

For example, in Fig. 7 of Ijichi, TRK3 located at the NUMBER "1" position in PL1 is not changed to TRK3 located at the NUMBER "3" position in PL2. Instead, Fig. 7 of Ijichi merely illustrates that the TRK3 in PL1 is located at the NUMBER "1" position and TRK3 in PL2 is located at the NUMBER "3" position.

The Final Office Action appears to interpret the "track number information" feature of independent claim 9 as the "NUMBER" positions of the playlists PL1 and PL2, illustrated in Fig. 7 of Ijichi. Such an interpretation is technically inaccurate for at least the following reasons.

Independent claim 9 of the instant application explains that when a track is moved from one playlist to another playlist, the track number information and the group management information is automatically edited. However, as discussed previously, the "NUMBER" positions of the playlists PL1 and PL2, illustrated in Fig. 7 of Ijichi are merely indications of the positions within the playlist. These numbers are never edited to any extent in Ijichi. For example, if a user selects PL1 in Ijichi, TRK3 will be reproduced first because it is located at the position of "NUMBER 1" in PL1. On the other hand, if a user selects PL2 in Ijichi, TRK3 will be reproduced third, after TRK5 and TRK 4.

On the other hand, in embodiments of the disclosure of the instant application, an editing instruction is issued in order to change a logical position of a track belonging to one group so that the track belongs to another group. For example, as shown in Fig. 9A, a logical position of a track having the track number "TNO2" was originally located at a second position in Group A. Then, the logical position of this track "TNO2" is changed as a result of an editing instruction so that it is now located at a second position in Group B.

Ijichi includes no teaching, or even a suggestion, of moving a track from one playlist to another playlist. This is an important feature of the disclosure of the instant application in that when a track is moved from one playlist to another playlist, the correspondence relationship of the track number information and the group management information is automatically edited in accordance with the new logical position of the track.

Independent claim 9 has been newly-amended to describe that the logical position of a track is changed based on an editing instruction so that the track now belongs to another group. Each of the remaining independent claims 13, 14, 17 and 18 include similar features in this regard. Accordingly, each of independent claims 9, 13, 14, 17 and 18 clearly differs from Ijichi at least in this respect.

Even further, in the example discussed above with regard to Fig. 9A of the instant application, as a result of track "TNO2" moving from Group A to Group B, track "TN02" no longer has a logical position in Group A. Applicants respectfully submit that this is because the track number information is uniquely imparted to each track in the information storage medium. Ijichi has no teaching or suggestion of such a feature. Accordingly, each of the independent claims 9, 13, 14, 17 and 18 has been newly-amended to include this feature.

As a result of this feature, as shown in FIG. 9A, the track number information of a track corresponding to a tune "c" is changed from "TNO3" to "TNO2". The track number information of a track corresponding to a tune "d" is changed from "TNO4" to "TNO3". The track number information of a track corresponding to a tune "b" is changed from "TNO2" to "TNO4". This feature is additionally described in independent claim 9 as "the correspondence relationship of the said track number information and said group management information is automatically edited in accordance with a new logical position of said track." This feature of editing track placement over a plurality of groups is not disclosed, or even suggested, in Ijichi.

At page 4 of the Final Office Action, the Examiner asserts that "the TOC also updates corresponding to the new logical position of TRK-TRK5." This assertion is strongly traversed by Applicants because there is no teaching or suggestion in Ijichi of updating the TOC in any respect. It is clear that no information indicated in the "TOC" of Fig. 7 of Ijichi is updated. Instead, as discussed previously, tracks from the TOC can be listed in more than one playlist (PL1 and PL2) at one time.

However, the information in the TOC is not edited in any respect as a result of using one or more of these tracks in particular playlists. This is a significant difference between the disclosure of embodiments of the instant application (in which the TOC is disclosed as capable of being edited based on updated editing instructions) and the disclosure of Ijichi. Instead, Ijichi teaches a simpler arrangement in which multiple playlists can be generated, but tracks are not moved from one playlist to another with automatic updating of group management information, as recited in the claims of the instant application.

Applicants respectfully submit that the TOC of Ijichi cannot be updated, for example, because the NUMBER position of TRK3 in PL1 is "1" and NUMBER position of TRK3 in PL2 is "3." Accordingly, two different NUMBER positions for TRK3 exist simultaneously. The TOC is not updated to any extent regardless of what happens in these separate and independent playlists PL1 and PL2. Even further, Ijichi's closest disclosure of "track number information" as described in connection with the instant application would be the pointers PTK1-PTK5 of the TOC shown in Fig. 7. Ijichi does

not teach or suggest updating the values of these pointers PTK1-PTK5 based on the generation of the playlists PL1 and PL2.

For at least the foregoing reasons, Applicants respectfully submit that Ijichi does not disclose, or even suggest, all of the features of the independent claims, especially as these independent claims are newly-amended.

With regard to the rejections under 35 U.S.C. § 103(a), the Examiner alleges in the previous Office Action dated October 25, 2004 that it “would have been obvious to someone within the level of skill in the art at the time of the invention was made to change the track number when imparts from one group to another group in IJICHI et al’s editing apparatus as claimed.” Applicants respectfully traverse this assertion as being technically inaccurate for at least the following reasons.

Applicants respectfully submit that Ijichi does not disclose, or even suggest, editing so as to cause a track belonging to one group to belong to another group. As explained previously, two separate and independent playlists PL1 and PL2 exist simultaneously in Ijichi. There is no disclosure of moving tracks between these two separate playlists, PL1 and PL2. Ijichi does not disclose, or even suggest, any idea with respect to "group management" as recited in the claims of the instant application, except for the mere generation of separate and independent play-lists. In these play-lists of Ijichi, no information is moved between playlists PL1 and PL2.

Thus, the Ijichi disclosure is similar to the arrangements disclosed in the Background portion of the instant application’s specification in which separate and independent playlists are processed. However, Ijichi surely does not disclose the features

of the independent claims of the instant application regarding the automatic editing of a unique track number information and group management information, when the logical position of a track is moved from one group to another group.

For example, in embodiments of the disclosure of the instant application, as shown, for example, in Fig. 9A, a logical position of a track having the track number "TNO2" belonging to Group A is changed to a second position in Group B as a result of an editing instruction.

Even further, Ijichi utilizes overlapping NUMBERS simultaneously in each of its disclosed playlists PL1 and PL2. However, track number information in embodiments of the disclosure of the instant application is uniquely imparted to each track in the information storage medium, as recited in newly-amended independent claims 9, 13, 14, 17 and 18.

Applicants respectfully submit that Ijichi does not disclose, or even suggest, any features with respect to "group management" except for the separate and independent playlists PL1 and PL2. The disclosure of Ijichi in this regard does not teach, or even suggest, editing over a plurality of playlists under the condition that the track number information in the present invention is uniquely imparted to each track in the information storage medium as recited in the newly-amended claims. As a result, Applicants respectfully submit that there is no motivation provided in the disclosure of Ijichi to suggest to a skilled artisan to change the track number between groups for at least these reasons.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because Ijichi does not teach or suggest each feature of independent claims 9, 13, 14, 17 and 18, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that dependent claims 10-12 and 15-16 are allowable at least because of their dependence from newly-amended independent claims 9 and 13, respectively, and the reasons set forth above.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the entry of the Amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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